REMARKS

This paper is responsive to a Final Office Action mailed January 24, 2006. Prior to this response, claims 1, 3-14, and 16-28 were pending. Claims 1, 3-14, and 16-28 remain pending.

In Section 4 of the Office Action claims 1, 3-14, and 16-28 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Yan et al. ("Yan"; US Patent 6,003,065), in view of Gimenez (US 2003/0182475). With respect to claims 1 and 13, the Office Action acknowledges that Yan does not describe an administrative policy that cross-references user-defined preferences for the usage of network-connected printers to print job characteristics. With respect to claim 18, the Office Action acknowledges that Yan does not describe a cost-basis administrative policy that cross-references printer usage on the basis of cost, to print job characteristics. The Office Action states that Gimenez describes a print verification component capable of communicating with a policy enforcement computer, to verify print policies, and for printing received documents. The Office Action further states that one of ordinary skill would have been motivated to combine the references in order to apply protection to a document. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Generally, Yan's system selects a printer from a pool on the basis of predetermined criteria such as speed, availability, or capabilities matching the print job. For example, at col. 18, ln. 37-43, Yan describes a peripheral device that is either manually selected, or selected by an application using "a predetermined set of characteristics", such as speed or capability. In his description of Fig. 3, Yan states that Step 302 selects a peripheral device on the basis of predetermined selection criteria. Step 304 provides the user with a prioritized list of devices. The user may manually select a device from the list. If the user does not make a selection, the application automatically selects the highest priority device from the list (col. 19, ln. 1-23).

Generally, Gimenez describes a system that permits a content owner to apply a set of policies to a job file that can be enforced at a printer device, where the printer converts the job file into a printed product [0009]. As an example Gimenez describes a job sent to a printer with a job ticket. The printer unwraps a MIME package to recover the job ticket, and sends the job ticket to a policy enforcement authority. The policy enforcement authority recovers a key from the job ticket, sends the key to the printer. The printer uses the key to decrypt the document for printing [0134]. Alternately, the policy enforcement authority can use a pointer instead of a job ticket [0136].

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"The content owner does not necessarily need to select a printer at the point of adding rights to the document at the policy editor. *The content owner does not have to select a printer at all, since this is not part of the policy which must be specified by the content owner to be enforced*" (emphasis added) [0142].

With respect to the first *prima facie* requirement, the motivation to combine references should not based upon a desire to "apply protection to a document", as suggested in the Office Action, since the claimed invention is not concerned with protection. The addition of document protection to the Yan invention, still does noting to suggest a modification that makes the claimed invention programmable administration policy obvious. While Yan selects a printer on the basis of predetermined selection criteria, Gimenez does not even address the subject of printer selection. Rather, Gimenez describes a policy concerned with securely printing a document. Alternately stated, the combination of the two references may suggest the addition of security features to Yan's system, after a printer has been selected. But Gimenez offers no suggestion for alternate or improved means of actually selecting a printer.

Considered from the perspective of the second *prima facie* requirement, even if an expert were given the Yan and Gimenez inventions as a foundation, there is no reasonable expectation that this expert could derive the claimed invention, since the claimed invention describes an invention where a printer is selected as the result of a programmable policy that cross-references printers to print job characteristics.

With respect to the third *prima facie* requirement, even if the references are combined, they do not disclose all the elements of the

claimed invention. The Applicant's claims 1 and 13 recite the elements of:
1) a programmable administration policy that cross-references network
printers to print job characteristics; and, 2) using the administration
policy to select a network printer, in response to the print job
characteristics. Yan does not describe programmable printer selection
criteria. Gimenez's policy editor and print verification component may be
concerned with verifying printer security policies and the conditions under
which printing is permitted, but these components have nothing to do
with the selection of a printer on the basis of print job characteristics. As
noted above, Gimenez explicitly states [0142] that printer selection is not
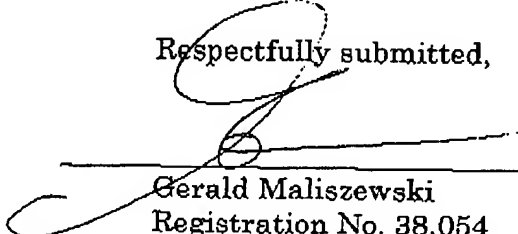part of the policy that is enforced.

     With respect to claim 28, neither reference describes the
elements of a programmable cost-basis administrative policy that cross-
references network printers to print job characteristics, or the selection of
a printer using the programmable policy.

     The combination of references does not explicitly describe
every limitation of the claims 1, 13, and 28. Neither does the combination
suggest any modifications that might make the missing limitations
obvious. Claims 3-12, dependent from claim 1, and claims 14 and 16-27,
dependent from claim 13, enjoy the same distinctions from the cited prior
art reference, and the Applicant requests that the rejection be withdrawn.

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It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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